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EXAMINER

THAKUR, VIREN A

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/301,868	BECKMAN, MARK JAMES	
	Examiner	Art Unit	
	VIREN THAKUR	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request on page 5 of the response to insert "50" on page 8, line 27 after the word "envelope" is hereby entered.
2. Regarding double patenting, applicant has several options. Applicant may cancel or amend the claims of either application over which the double patenting rejection was made so as to obviate the rejection. Applicant may also obviate the double patenting rejection by abandoning one of the applications.
3. Applicant's response references attachment 1 on page 3 and attachment 3 on page 18. Applicant's response does not appear to include these attachments or otherwise has not clearly labeled these attachments within the response. Attachment 2 and attachment A have been received.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Instant claims 1, 6 and 10 recite the limitation "diminished diameter." It is not clear as to from what the diameter is diminished. The product claims recite the structure at a specific state in time. Therefore, without providing an appropriate frame of reference to define from what the diameter is diminished, the bottle neck would already include a "diminished diameter." In other words, without an appropriate comparison the limitation "diminished diameter" is the diameter of the bottle neck.

The instant claims further recite the limitation "intimate" or "intimately." Further clarification is required in order to appropriately define the metes and bounds of the limitation "intimately." It is not clear as to what degree of interaction would be considered intimate.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 10 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schumacher et al. (US 5465835).**

The reference and reasons for rejection are taken as applied in the prior Office Action, mailed April 3, 2007.

8. **Claims 10, 14-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Muza et al. (US 5397017).**

The reference and reasons for rejection are taken as applied in the prior Office Action, mailed April 3, 2007.

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9. Claims 10, 14-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Selz (US 4693410).

The reference and reasons for rejection are taken as applied in the prior Office Action, mailed April 3, 2007.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1, 6, 10, 14-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brauner et al. (US 5372827) in view of Srigley et al. (US 3256978) and Nedblake, Jr. (US 5664671).

Regarding instant claims 1, 6 and 10, Brauner et al. disclose a drink bottle (Figure 4, Item 12 and see abstract), comprising a diminished diameter bottle neck (Figure 4, Item 16), a sealed snack package containing a snack food (Figure 4, Item

20). The instant claims recite functional language, such as "for," "adapted for," and "enabled for." The Examiner asserts that in product claims, the prior art need only recite the structure of the limitations. If the prior art meets the structural limitations, then the prior art would have been capable of performing the recited intended use. In particular, regarding instant claim 10, said snack package is capable of and thus adapted for being wrapped around the bottle neck of the drink bottle for intimate abutment therewith. The Examiner notes that if the prior art discloses the claimed structure, then said prior art would have been capable of performing the recited intended use. In this case, said snack package is adapted for being wrapped around the bottle neck of the drink bottle and is further capable of intimate abutment therewith. As can be seen by Figure 4, and in light of the rejection under 112, second paragraph, above, the snack package is considered intimately abutted with the bottle neck.

Instant claims 1, 6 and 10 differ in reciting wherein the bottle is cylindrical.

Nevertheless, Brauner et al. teach wherein the sample package is useful in connection with conventional plastic containers for fluid foods such as milk, juice and water (Column 2, Lines 21-24) and further teach wherein the container can be a jug or a bottle (See Abstract). It would have been obvious to the skilled artisan that conventional plastic containers for fluids such as juice and water include bottles having a cylindrical wall. Franco on Figure 6 and Column 2, Lines 25-33, is cited as further evidence of the commonality of cylindrical bottles to hold fluids such as water. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the invention of Brauner et al. could have also have been used with a cylindrical bottle.

Instant claims 1 and 6 further differ from Brauner et al. in how the drink bottle is associated with the snack package.

Srigley et al. teach that it has been conventional in the art to use an enclosing element to hold two portions of a package together (Figure 1, Item 37). Brauner et al. teach using a snap fitting means for associating the snack package with the drink bottle. Therefore, to modify Brauner et al. and substitute one conventional associating feature

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for another, such as the enclosing band of Srigley et al., would have been obvious for the purpose of associating two containers together.

Nedblake Jr. provides further evidence of the conventionality of using a coupling means (Column 2, Lines 24-35) for the purpose of associating a secondary container to a primary container.

Regarding the envelope being cylindrical, it is asserted that the envelopes of Srigley et al. and Nedblake Jr. are cylindrical and have an aperture at one end thereof, which are capable of, or "adapted for" accepting the bottle neck and for positioning an inner surface of the envelope wall intimately against the bottle wall for securement therewith. It is further asserted that by using the envelope of Srigley or Nedblake, some amount of pressure would have been imparted for pressing the snack package of Brauner against the bottle neck.

Regarding instant claims 14 and 15, Brauner et al. disclose a catch mounted on the inner wall (Figure 4, Item 60) that engages the bottle neck. Since said catch protrudes inwardly toward the bottle neck, the Examiner interprets that said catch is an inwardly radially directed protuberance. Regarding instant claim 15, since said protuberance conforms to the cylindrical bottle neck, said protuberance is an annular ridge.

Regarding instant claim 17, Brauner et al. disclose wherein the envelope has an access means in opposition to the bottle cap (Figure 4, Item 30) that enables access to the snack food.

13. Claims 2-4, 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1, 6, 10, 14-15 and 17, above in paragraph 11, and in further view of Lemelson (US 3112824).

Brauner, Srigley and Nedblake are taken as applied above.

The claims differ in explicitly teaching wherein the envelope comprises a cap sheath.

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Regarding instant claim 2, Lemelson teaches using an associating means, such as that shown in figure 9, item 11 and figure 10, item 52 for securing a secondary container to the primary container. Column 1, Lines 42-48 and column 2, lines 10-13 and 48-54 teach a "sub container" secured to a closure of a "basic container" thus teaching a similar concept to that of applicant of using a secondary means of securely associating two containers together. By securing the sub-container to the basic container, Lemelson teaches preventing pilfering of the contents of the sub-container. Lemelson thus teaches that it has been conventional in the art to use an enclosing element to hold two portions of a package together and thus would have been obvious to the ordinarily skilled artisan to use the associating means, as taught by Lemelson for the purpose of preventing pilfering of the contents of the sub-container.

Lemelson teaches an envelope comprising an annular cap sheath (Figures 9 and 10, see envelope close fitting to cap) adapted for frictional engagement, for the purpose of securing the envelope to the drink bottle. It is noted that a sheath is known in the art as a close fitting covering. Therefore, it is asserted that the envelope Lemelson provides a sheath adapted for frictional engagement with the bottle cap for the purpose of securing the sub-container to the basic container.

Regarding instant claims 3-4, 7-8 and 11-12, Lemelson teaches using an adhesive layer or strip for joining the inner surface of the envelope to the cylindrical wall (Column 4, Line 68 to Column 5, Line 3) and a plurality of bosses (Figure 9, Item 11b and 13').

By using an adhesive layer or strip, Lemelson teaches a means for securing the enveloping means to the container and thus preventing the dislodgement of the container holding the premium item. As a problem with the prior art, Brauner et al. teach that the sample must be relatively easy to remove from the bottle but also wherein the securing means is strong enough to maintain the sample package on top of the bottle (Column 2, Lines 3-13 and 30-35). Thus, the teachings of Lemelson teach to one having ordinary skill in the art that it would have been obvious to use an adhesive tape or layer with the sample package of Brauner et al., so as to provide a strong securing means that is resistant to dislocation but is still simple to remove.

14. Claims 5, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1, 6, 10, 14-15 and 17, above in paragraph 11, and in further view of Turpin (US 3962476) and Akutsu et al. (US 4779738).

Brauner et al., Srigley et al. and Nedblake Jr. are taken as applied above.

Turpin and Akutsu et al. and the reasons for rejection are taken as applied in paragraph 23 of the prior Office Action, mailed April 3, 2007.

15. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1, 6, 10, 14-15 and 17, above in paragraph 11, and in further view of Singer (US 6085919).

Brauner et al., Srigley et al. and Nedblake Jr. are taken as applied above. Singer and the reasons for rejection are taken as applied in paragraph 21 of the prior Office Action, mailed April 3, 2007.

16. Claims 1-2, 6, 10, 14-15 and 17 are rejected under 35 U.S.C. 103(b) as being unpatentable over Franco (US 5743423) in view of Srigley et al (US 3256978), Lemelson (US 3112824) and Nedblake, Jr. (US 5664671).

Franco teaches cylindrical drink bottle with a diminished diameter bottle neck (Figure 1), with a sealed snack package containing a snack food (Figure 4); wherein the snack package is adapted for wrapping around and over the bottle neck of the drink bottle. Regarding instant claim 10, the snack package and the envelope are the same and thus, Figure 4, Item 10 is interpreted as the snack package envelope, terminating with an aperture at one end thereof (Figure 4, Item 20), wherein the aperture wherein the aperture is adapted for accepting the bottle neck (Figure 3) and capable for positioning of an inner surface of the envelope wall intimately against the bottle wall (Figure 3). In light of the rejection under 112, second paragraph, above, the Examiner interprets that if any portion of a wall is in contact with the bottle wall, then said wall is in

intimate contact with said bottle wall. Franco further discloses wherein the envelope is frictionally engaged with the bottle cap and thus the snack package envelope inherently presses against the bottle neck.

Regarding instant claims 1 and 6, Franco is silent in teaching an envelope used to associate the snack package with the drink bottle.

Srigley et al. teach that it has been conventional in the art to use an enclosing element to hold two portions of a package together (Figure 1, Item 37). Brauner et al. teach using a snap fitting means for associating the snack package with the drink bottle. By securing the sub-container to the basic container, Lemelson teaches preventing pilfering of the contents of the sub-container. Lemelson thus teaches that it has been conventional in the art to use an enclosing element to hold two portions of a package together.

Therefore, to modify Franco and substitute one conventional associating feature for another, such as the band of Srigley et al., would have been obvious for the purpose of associating two containers together.

Nedblake Jr. provides further evidence of the conventionality of using a coupling means (Column 2, Lines 24-35) for the purpose of associating a secondary container to a primary container.

Further regarding instant claims 1, 6 and 10, Franco is silent in teaching wherein the envelope wall extends diametrically from the bottle wall no more than by the thickness of the envelope wall. It is noted that the amount by which the envelope extends so as to occupy the same space as the bottle is also dependent on the size of the bottle. On column 2, lines 15-24, Franco teaches decreasing the amount of storage space and minimizing the ground space required by the bottles. Therefore, depending on the type and size of bottle, it would have been obvious to one having ordinary skill in the art that the envelope would have not extended past the width of the bottle. Such a modification would have been obvious, since bottles are well known to be shelved side by side while also maximizing the given shelf space. Thus it would have been obvious to the skilled artisan that sizing the snack package to not extend diametrically farther

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than the bottle would have allowed the combination package to be shelved without occupying additional shelf space.

Regarding instant claims 14-15 and 17 Franco is silent in teaching a catch mounted on the inner wall and fabricated in the form of an inwardly radially directed protuberance; wherein the protuberance is an annular ridge.

Regarding instant claims 14-15 and 17 Franco teaches wherein the protuberances are mounted on the bottle neck (Figure 6, Item 24). However, to change the orientation of the protuberances so that the protuberances were on the snack envelope and not the bottle neck would have been an obvious expedient of the prior art. By changing the positioning of the protuberance would not have modified the operation of the bottle (See MPEP 2144.04 VI), and thus would not have provided a patentable feature over the prior art.

Regarding instant claim 17, Franco discloses wherein the envelope has an access means positioned in opposition to the bottle cap (Figure 4, Item 10) to enable access to a snack food.

Regarding instant claim 2, Franco discloses a sheath (Figure 3, Item 22) for frictional engagement with the bottle cap.

17. Claims 3-5, 7-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the as applied to claims 1-2, 6, 10, 14-15 and 17, above in paragraph 15, and in further view of Willis (US 4544073).

Franco, Srigley, Lemelson and Nedblake are taken as applied above. Willis and the reasons for rejection are taken as applied in paragraph 26 of the prior Office Action, mailed April 3, 2007.

18. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1-2, 6, 10, 14-15 and 17, above in paragraph 15, and in further view of Singer (US 6085919).

Franco, Srigley et al., Lemelson and Nedblake Jr. are taken as applied above. Singer and the reasons for rejection are taken as applied in paragraph 25 in the prior Office Action, mailed April 3, 2007.

19. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher et al. (US 5465835) in view of Willis (US 4544073). Akutsu et al. (US 4779738) is cited as evidence, as discussed in the prior Office Action.

Schumacher et al. is taken as cited above.

The reference and reasons for rejection are taken as applied in paragraph 27 of the prior Office Action, mailed April 3, 2007.

20. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muza et al. (US 5397017) in view of Willis (US 4544073).

Muza et al. are taken as cited above.

The reference and reasons for rejection are taken as applied in paragraph 28 of the prior Office Action, mailed April 3, 2007.

21. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selz (US 4693410) in view of in view of Willis (US 4544073). Akutsu et al. (US 4779738) is cited as evidence, as discussed below.

Selz is taken as cited above.

The reference and reasons for rejection are taken as applied in paragraph 29 of the prior Office Action, mailed April 3, 2007.

22. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muza et al. (US 5397017) in view of Singer (6085919).

Muza et al. are taken as cited above.

The reference and reasons for rejection are taken as applied in paragraph 30 of the prior Office Action, mailed April 3, 2007.

23. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Selz (US 5397017) in view of Singer (6085919).

Selz is taken as cited above.

The reference and reasons for rejection are taken as applied in paragraph 31 of the prior Office Action, mailed April 3, 2007.

Double Patenting

24. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

25. Instant claims 1-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-17 of copending Application No. 09301868. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Response to Arguments

26. Upon reconsideration, the rejection of claims 10-17 under 35 U.S.C. 112, first paragraph has been withdrawn.

27. Upon reconsideration, the rejection of claims 14-17 under 35 U.S.C. 112, second paragraph for the limitation "inwardly radially directed protuberance" has been withdrawn. Figure 7 item 58 clearly shows the inwardly radially directed protuberance" directed towards the neck of the drink bottle.

28. The objection to the specification has been withdrawn.

29. The rejection of claims 1 and 6 as being anticipated by Barton has been withdrawn since Barton does not disclose an envelope.

30. Since applicant is withdrawing the request to insert "20" after snack package on page 8, the objection to the drawings is also withdrawn.

31. Applicant's arguments with respect to the limitation "diminished diameter" on page 8, have been carefully considered but are not deemed persuasive. It is respectfully asserted that the limitation "diminished diameter" does not clarify with respect to what the diameter is diminished. The limitation is attempting to state a size comparison of the diameter of the bottle neck however that comparative has not been provided. As has been stated in the prior Office Action, the claim limitations require a comparison to which the diameter of the bottle neck is diminished. For instance, is the diameter diminished in comparison to another sized bottle or in comparison to another part of the drink bottle?

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32. On pages 7-10 of the response, applicant states that the instant invention precisely teaches that the ability to insert the combined object into the vending machine also depends on the size of the vending machine and the relative size of the object.

The point that the examiner attempted to make was that the claims are directed to a product, in this case, a combination drink bottle. The claims do not recite that the product must be vended. Even if the product was *capable of* being vended, it is asserted that the ability to vend a bottle of the prior art would have been dependent on the size of the vending machine and the relative size of the object. Since vending machines are capable of dispensing various sized drink bottles and other product, there would have been a reasonable expectation of success that the prior art would also have been capable of being vended.

33. Applicant's arguments with respect to the limitation "substantially" on pages 8-9 are not deemed persuasive. On page 8, applicant states that "patents rarely contain actual measurements or dimensions, the language of this patent application is stated in the abstract, teaching the working with reasonable sized elements which are easily discerned by one skilled in the art of loading a vending machine as conveyed in the limitation that the combination MUST not exceed the size of the pigeon hole." It is noted that the claims do not reflect this argument. Applicant has not claimed a vending machine and further has not clearly defined what is considered substantially the same space. It is asserted that substantially the same space and "not exceeding the size of a pigeon hole" are not the same limitations.

Applicant has further not provided a definite degree which would be considered intimate. On page 9, applicant states that that "...one skilled in the art will choose a bottle and snack food combination to fit within the pigeon hole so as to not leave any pigeon hole droppings. Thus appropriate metes and bounds are clearly established by applicant and continue to govern/limit as to how intimate the interaction of the elements of the bottle, snack food package and envelope with all of their individual walls must coexist within said pigeon hole of the pre-existing vending machine."

It is asserted that this argument is not commensurate in scope with the claims. Additionally, the claim language recites intimately against the bottle wall but the claim is still unclear as to how close the two walls must be in order to be considered intimate.

34. On pages 10-11 of the response, applicant states that "severe limits are recited in the supporting specification of how the combination must be structures so as to function within a defined size and shape. Therefore, not just any bottle, snack package and envelope will meet the limitations of capable of being vended in a standard vending machine." This argument has been carefully considered but is not deemed persuasive. It is respectfully asserted that the claims do not recite vending the product. In light of the discussion above, it is asserted that even if the product was capable of being vended, the ability to vend a bottle would have been dependent on the size of the vending machine and the relative size of the object. Since vending machines are capable of dispensing various sized drink bottles and other product, there would have been a reasonable expectation of success that the prior art would also have been capable of being vended. It is further asserted that the "severe limits" mentioned in the supporting specification have not been claimed and therefore applicant's arguments are not commensurate in scope with the claims.

It is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims have not provided any substantial limitations which would further support applicant's assertion that "not just any bottle, snack package and envelope will meet the limitations of capable of being vended in a standard vending machine." Aside from the fact that the limitation is not in the claims, it is further noted that the term "standard vending machine" is non-limiting in the argument. It is not clear as to what could be considered a standard vending machine. As is known in the art, vending machines can be of a variety of sizes and dimensions and can vend a variety of product. Therefore, the argument of vending from a standard vending machine is not persuasive.

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Further to this argument, applicant's states on page 12, that the bottle of Schumacher is not an item that could be placed in a vending machine accessible by minors. This argument has been carefully considered but is not deemed persuasive. Applicant asserts that the invention of Schumacher may be used to place an alcoholic beverage. It is not clear where in Schumacher it is stated that the container is used for an alcoholic beverage. On column 5, lines 39-45, Schumacher states using beverage syrup.

35. On page 12 of the response, applicant states that Schumacher lacks a bottle and the envelope of the applicant's invention. This argument has been carefully considered but is not deemed persuasive. The examiner notes that the claim recites wherein the snack package is fabricated as an envelope having an inner wall and an outer wall, and having a sealable opening mounted on said outer wall for removable receiving a snack food. Schumacher et al. anticipate this limitation since the snack package is the envelope in the instant claim. The bottle can clearly be seen as item 2 in figure 1, as cited in the prior Office Action. Regarding the snack, it is asserted that the claim recites a snack package for removably receiving a snack food. Therefore, the prior art meets the structural limitations of the claim and must only be capable of receiving a snack. Nevertheless, Schumacher discloses on column 5, lines 39-45 that the container can comprise a beverage syrup. Therefore the entire package would have been known to have contained an edible product. Since applicant has not defined the limitation snack food, to interpret the beverage syrup as a snack is a reasonable interpretation of the claims.

36. On page 12 of the response, applicant states that Muza does not disclose a filled snack package, a filled bottle held together with an envelope. It is respectfully asserted that instant claim 10 does not recite these limitations. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected

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claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, instant claim 10 recites wherein the snack package is fabricated as an envelope. The claim does not recite wherein the snack package actually contains a snack therein but rather that the snack package is for, or capable of, receiving a snack food.. Also the instant claim does not recite a filled bottle.

37. On page 13 of the response, applicant states that Selz does not have a bottle, it must be supplied by the user. This argument has been carefully considered but is not deemed persuasive. The art discloses in the figure, a bottle and a snack package envelope, and thus anticipated the claim limitations. Applicant further states that "the examiner appears to have formed the opinion that if the prior art discloses some structure that looks like it could have a snack food stuffed into it and said structure is attachable to some bottle it is proper prior art. The examiner agrees that this is true. It is asserted that under 35 U.S.C. 102(b), the invention must have been patented or described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of the application for patent in the United States. In this case, the invention, as *claimed* is read on by the prior art, and since the prior art was printed at least one year prior to the effective filing date of the instant application, applicant's invention is anticipated by the reference. It is further asserted that in product claims, the prior art must meet the structural limitations of the claims. As stated in the prior Office Action, the reference to Selz would have been capable of performing the function of holding a snack food therein. Applicant has not provided any convincing arguments that what is referred to as a snack package envelope in Selz would not have been capable of performing the function of receiving a snack food.

38. Applicant further states that the examiner makes many references to snack food, however, Selz makes no such references. It is asserted that the instantly rejected claims do not positively recite a snack food contained therein. The instant claims recite

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the limitation "a snack package envelope," which must only be capable of receiving a snack food: "for removably receiving a snack food." In light of the lack of a positive recitation of a food product contained therein, the prior art still meets the structural limitations of the instantly rejected product claims, and anticipate the claims.

39. Applicant's arguments on page 14 with respect to Brauner not teaching an envelope are moot in view of the new grounds of rejection discussed above.

40. Further on page 14 with respect to the Singer reference, applicant states that "no teaching of Singer indicates the use of the Singer combination with a vending machine or adding value to contents of the bottle." It is asserted that the claims do not recite a vending machine. It is unclear as to how "adding value to contents" affects the claim limitations. Singer is relied on to teach protuberances. It is further noted that claim 16 depends on instant claim 10, which recites wherein the snack package is the envelope (i.e. a snack package envelope).

41. On page 15, applicant states that Turpin has no bottle however, Turpin is relied on for teaching the concept of a spiral score line used to dislodge a first food item from a second food item. Applicant further states that "Turpin holds a food item but said food item of Turpin must be cooked. Turpin does not provide a self heating container so the user must drag a stove/over around to use Turpin to practice the consumption of the snack." Applicant has not defined what constitutes a snack, and further, the claims do not limit the invention to cooked snack products. Regardless, Turpin is not relied on for the food product but rather for teaching spiraling score lines. Regarding Lemelson, it is asserted that Lemelson teaches using a sheet that envelopes a first and second container for the purpose of securing the two containers together, as discussed in the rejections above. It is noted that Akutsu et al. is similarly cited for the same reasons as Turpin: for teaching spiraling score lines.

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42. With respect to Franco, applicant states that Franco teaches using salt to fill the package and as such salt could not be considered a reasonable snack. It is asserted however, that applicant has not defined the term snack package and Franco teaches his invention could be used as "...a way to store items with an associated bottle. For example, mixers could be stored with a liquor, seasoning could be kept with salad dressing..." Thus, Franco teaches more than simply using salt. In light of the fact that applicant has not defined a snack package, seasoning could be reasonably interpreted as a snack, for instance. The missing element of Franco is the envelope, but this element is not required in claim 10, since the snack package is the envelope.

Therefore, the container of Franco, reads on the snack package envelope of claim 10. Regarding claims 1 and 6, Srigley, Lemelson and Nedblake Jr. are relied on to teach the envelope. Applicant further states that "the examiner does not discuss the source of the bottle to be from a vending machine but appears to pull the bottle out of a box to be placed on a shelf. The examiner then discussed the limitation of this activity as placing constraints on the size of the combination. This is exactly the point of applicant's invention... applicant's attorney respectfully request the examiner to acknowledge that the language used by applicant must be read to incorporate limitations easily understood by one skilled in the art."

This argument has been considered but is not deemed persuasive. Every attempt has been made to ensure that applicant's limitations are understood by one skilled in the art. However, based on applicant's disclosure and providing a reasonable interpretation of the claims, it is asserted that the prior art reads on the invention as recited in the rejected claims. Additionally, it is noted that the claims do not recite placing the combination in a vending machine but rather only state that the combination should occupy "substantially the same space as a drink bottle alone", for instance.

43. Regarding instant claim 14, applicant states that "the examiner has formed the opinion that Muza discloses a catch, however applicant's attorney reads item 32 as a threaded portion. This argument has been carefully considered but is not deemed persuasive. It is respectfully asserted that the claim recites wherein "a catch is mounted

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on the inner wall for engagement with the bottle neck" and "said catch fabricated in the form of an inwardly radially directed protuberance." Since what is interpreted as the catch of Muza (Figure 3, Item 32) engages the bottle neck, it is asserted that the examiner's interpretation of item 32 of Muza as a catch is reasonable.

44. Regarding Schumacher, Muza, Selz, on pages 17-18 of the response, applicant states with respect to the rejections of claims 11-13 that the combined references do not teach the use of an envelope. As previously stated, it is asserted that the claim recites wherein the snack package is an envelope and thus, the references to Schumacher, Muza and Selz teach a snack package that is an envelope. As previously stated, the claim does not positively recite a food product but rather recites wherein the snack package envelope is for receiving a snack food. Therefore the prior art need to have a food product contained therein. Applicant has similar arguments with respect to the rejection of claim 16, in paragraphs 22 and 23 of the previous Office Action. The examiner again asserts that the independent claim from which claim 16 depends recites wherein the snack package is also an envelope.

45. Regarding the limitation of "adapted for" it is noted that the claims recite the claimed structure. For example, the prior art teaches a sealed snack package, such as in Brauner et al. and Franco. In both cases, the snack package comprises an aperture and thus is considered "adapted for" being wrapped around the neck of the drink bottle for intimate abutment therewith. Applicant states that the prior art does not disclose an envelope. The Examiner respectfully disagrees. Based on the response to the argument above as well as the rejections, it is noted that the prior art teaches an envelope and a snack package that is the envelope.

Conclusion

46. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIREN THAKUR whose telephone number is (571)272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/V. T./

Examiner, Art Unit 1794

Steve Weinstein
STEVE WEINSTEIN
PRIMARY EXAMINER 1794
2/4/08